

### **Remarks**

Applicant would like to thank the Office for entering the Applicant's amendment and response dated November 27, 2007. Applicant notes that the summary page of the Office Action mailed December 20, 2007, indicates that the Office Action is responsive to the communication filed on February 23, 2005. Applicant believes that this date is incorrect and respectfully requests the Office to confirm that the date should instead be December 3, 2007, which is the date reflected on the return receipt postcard mailed from the U.S. Patent and Trademark Office for Applicant's last communication, a copy of which is included herewith for the Office's convenience.

Claims 1-13 were pending in this application, one or more have been objected to or have been rejected. By way of this amendment, claims 1, 3, 6, 7, 9, 10 and 11 have been amended to more fully claim the subject invention, new claim 14 has been added and claim 2 has been canceled without prejudice. Support for the claims amendments and new claims can be found in the originally filed specification, claims and Figures. *No new matter has been added.*

The foregoing amendments were made solely in an effort to expedite prosecution and allowance of the present application. The applicant reserves the right to pursue the claims as originally filed in this or a separate application(s).

Accordingly, upon the entry of the present amendment and response, claims 1 and 3-14 will remain pending.

### **Claim Objection**

Claim 7 has been objected to because of a typographical error in the claim. Applicant has amended the claim to replace the term "vertical protecting portion" with "vertical projecting portion," thereby obviating this objection.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of this objection.

### **Rejection Under 35 USC § 112, Second Paragraph**

Claim 10 has been rejected as allegedly lacking antecedent basis for the term "said head support."

Claim 10 has been amended such that no longer recites the limitation of "said head support," thereby rendering this rejection moot. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection.

**Rejections Under 35 USC § 102/103**

**I. Claims 1-3 and 8**

The rejection of claims 1-3 and 8 as allegedly being anticipated under 35 USC §102(e) by, or in the alternative, under 35 USC §103(a) as being obvious over U.S. Patent No. 6,884,341, in the name of Ferguson (hereinafter referred to as "*Ferguson*") has been maintained on the ground that *Ferguson* "teaches a vacuum filter system having a reception surface which holds a filter, a vacuum connection (see figures 2a-c and 3a-c), a pressure sensor in a passage which vents to the outside, and a filter in the reception surface." (See, page 3 of the Office Action mailed 12/20/07). Further, the Office acknowledges that *Ferguson* does not specifically teach a solenoid valve (see page 4 of the Office Action mailed 12/20/07), however, takes the position that it teaches a pressure sensitive check valve in figure 3a-b and vent 214 with valve 213 in figure 2b-c and that this teaching is considered equivalent to the "valve means" claimed. *Id.*

Applicant respectfully traverses this rejection. For a prior art reference to anticipate a claimed invention under 35 U.S.C. §102, the prior art reference must teach ***each and every limitation*** of the claimed invention. See, *Lewmar Marine v. Barient* 827 F.2d 744, 3 USPQ2d 1766 (Fed. Cir. 1987). Applicant submits that *Ferguson* fails to teach or suggest each and every limitation of the claimed invention at least for the reasons enunciated in Applicant's response filed on November 27, 2007, as well as discussed *infra*.

Further, a proper *prima facie* obviousness rejection requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Additionally, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. §2143. Also, see *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1443 (Fed. Cir. 1991) (the teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure).

Applicant also notes that in a recent case, *KSR International Co. v. Teleflex Inc. et al.* (127 S. Ct. 1727 (2007)), the Supreme Court stated that "[r]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

It appears that the Office has based this rejection on the ground that the pressure valve disclosed in *Ferguson* is equivalent to the selectively operable closure means. Applicant notes that consistent with the legal principle enunciated by the Supreme Court in *KSR*, the Office has failed to provide a reason which would have prompted one of ordinary skill in the relevant art to conclude that the pressure sensor check valve of

*Ferguson* is an equivalent of the valve of the claimed invention, as explained in detail *infra*.

As an initial matter, Applicant respectfully points out that without acquiescing to the validity of this rejection and solely in an effort to expedite prosecution and allowance of the pending claims, Applicant has amended independent claims 1 and 11 to specify that the selectively operable means comprises ***a valve adapted to slide in a bore which discharges onto an external surface portion of a reception head to drive said valve in translation between said first position and said second position.*** Applicant submits that in addition to the various differences between the claimed invention and the device in *Ferguson*, as previously enunciated in the response filed on November 27, 2007, *Ferguson* also does not teach the valve, as now claimed. Specifically, Applicant notes that contrary to the Office's contention, the claimed valve is not an equivalent of the pressure sensitive check valve disclosed in *Ferguson*. Specifically, the valve included in the mechanical support of the claimed invention is not a valve which responds to pressure. Instead, ***the valve is operated from outside the head.*** See, for example, paragraph [0018]. Such a valve is used to open the passage, both when the filter unit is mounted and removed, in order ***to let the air trapped between the membrane and the reception surface to escape,*** thereby to prevent deterioration of the membrane.

In contrast, the device of *Ferguson* includes ***a pressure sensitive check valve, e.g., depicted by the reference numeral 320.*** The pressure sensitive check valve in the device of *Ferguson* is ***responsive to pressure and monitors the flow rate through the filter membrane.*** See, for example, col. 7, line 51 through col. 8, line 28. Accordingly, the pressure sensitive check valve in the device of *Ferguson* is different both in structure as well as function from the claimed selectively operable means. Specifically, not only does the pressure sensitive check valve of *Ferguson* fail to include the claimed structure, *i.e.*, a valve adapted to slide in a bore which discharges onto an external surface portion of a reception head to drive the valve in translation between a first and a second position, as now claimed, but the valve in the device of *Ferguson* is used for a completely different function, *i.e.*, monitoring the flow rate of liquid through the membrane versus for removing the trapped air, as in case of the claimed invention.

Accordingly, based on the teachings of *Ferguson*, one of ordinary skill in the art would not have been motivated to replace the pressure sensitive check valve in *Ferguson* with the valve in the claimed device as the valve in the claimed device is designed to perform a completely different function and does not yield the same result as the valve in the device of *Ferguson*.

In view of the foregoing, Applicant submits that *Ferguson* fails to teach, disclose or suggest the claimed mechanical support of the instant invention or any equivalents thereof, and accordingly, requests reconsideration and withdrawal of this rejection.

## II. Claims 1-6, 8-11 and 13

Claims 1-6 and 8-10 have been rejected as allegedly being anticipated under 35 USC §102(b) by, or in the alternative, under 35 USC §103(a) as being obvious over U.S. Patent No. 6,027,638, in the name of Johnson (hereinafter referred to as "*Johnson*"). Additionally, claims 11 and 13 have been rejected as allegedly being obvious over *Johnson*.

Applicant respectfully traverses this rejection. As discussed *infra*, for a prior art reference to anticipate a claimed invention under 35 U.S.C. §102, the prior art reference must teach *each and every limitation* of the claimed invention. See, *Lewmar Marine v. Barient* 827 F.2d 744, 3 USPQ2d 1766 (Fed. Cir. 1987). At least for the reasons set forth below, Applicant respectfully submits that *Johnson* fails to teach each and every limitation of the claimed invention.

Furthermore, as discussed above, in a recent case, *KSR International Co. v. Teleflex Inc. et al.* (127 S. Ct. 1727 (2007)), the Supreme Court stated that "[r]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

Applicant submits that like *Ferguson*, *Johnson* also fails to disclose a mechanical support for a filter unit which includes *a valve adapted to slide in a bore which discharges onto an external surface portion of a reception head to drive said valve in translation between said first position and said second position*. Instead, the valves in the device of *Johnson* are *opened and closed by vacuum*. The vacuum opens the valves in the device of *Johnson*, *thereby to aspirate the sample*. In contrast, in case of the claimed invention, the valve is *operated from outside the head* which is used to open the passage, both when the filter unit is mounted and removed, in order *to let the air trapped between the membrane and the reception surface to escape*, thereby to prevent deterioration of the membrane.

Further, Applicant notes that independent claim 11, as amended, recites the limitation of *a valve adapted to slide in a bore which discharges onto an external surface portion of a reception head to drive said valve in translation between said first position and said second position* and accordingly, is also not obvious, at least for the reasons set forth above.

In view of the foregoing, Applicant submits that the claimed invention is both novel as well as obvious over *Johnson* and, accordingly, requests reconsideration and withdrawal of this rejection.

**Conclusion**

In view of the foregoing amendments and arguments, allowance of the instant application with all pending claims is respectfully solicited. If a telephonic conversation with Applicant's attorney would help expedite the prosecution of the above-identified application, the Examiner is urged to call the undersigned at the number below. Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account no. 13-3577.

Respectfully submitted



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